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James T. Mihm

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EXAMINER

PATEL, HARESH N

ART UNIT

PAPER NUMBER

2154

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/820,532	Applicant(s) MIHM ET AL.	
	Examiner Haresh N. Patel	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-25 are subject to examination.
2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn and new ground(s) of rejection is presented

Double Patenting Rejection

3. Applicants statement regarding the double patenting rejection is noted, i.e., Since the '037 appl. has not yet issued, it is improper to require a terminal disclaimer or to reject the claims based on an obviousness-type double patenting rejection. This rejection should have been provisional, contingent upon the issuance of the '037 appl. If the '037 appl. should issue before the present application, Applicants agree to file a terminal disclaimer to said patent. However, until such time, Claims 1-25 are in condition for immediate allowance and should be permitted to issue at the earliest possible time (please refer to previous office action of the prosecution history).

Terminal Disclaimer

4. The terminal disclaimer filed on 1/9/2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,990,577 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3, 8, 9, 14, 15, 16, 20-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Tobias et al. 7,293,165 (Hereinafter Tobias).

7. Referring to claim 1, Tobias discloses a method for automatic firmware image recovery, comprising: determining that a firmware image for server management operational code in a recipient system needs to be replaced (e.g., col., 3); sending a message over a network by the recipient system, wherein the message requests a compatible replacement firmware image (e.g., col., 3); negotiating with a donor system based on a received acknowledgement that the donor system has a compatible image (e.g., col., 4), using a predetermined policy to select the donor system from a set of at least one donor system having a compatible image (e.g., col., 4), wherein at least one donor server of the set of at least one donor system sends an acknowledgement to the recipient system in response to the sent message (e.g., col., 4); uploading a compatible image sent by the donor system to the recipient system; and updating the recipient system firmware with the uploaded compatible image (e.g., col., 4).

8. Referring to claims 3, 9, 22, Tobias discloses the claimed limitations as rejected above. Tobias also discloses wherein the network is selected from a group consisting of a wired network and a wireless network (e.g., col., 3).

9. Referring to claim 8, Tobias discloses the claimed limitations as rejected above. Tobias also discloses a machine accessible storage medium containing instructions that, when executed, cause a machine to: determine that a firmware image for server BIOS code in a recipient system needs to be replaced (e.g., col., 3); send a message over a network by a baseboard management controller on the recipient system, wherein the message requests a compatible replacement firmware image (e.g., col., 3); negotiate with a donor system based on a received acknowledgement that the donor system has a compatible image (e.g., col., 4), using a predetermined policy to select the donor system from a set of at least one donor system having a compatible image (e.g., col., 4), wherein at least one donor system of the set of at least one donor system sends an acknowledgement to the recipient system in response to the sent message (e.g., col., 4); upload a compatible image sent by the donor system to the recipient system (e.g., col., 4); and update the recipient system firmware with the uploaded compatible image (e.g., col., 4).

10. Referring to claim 14, Tobias discloses the claimed limitations as rejected above. Tobias also discloses a machine accessible medium containing instructions that, when executed, cause a machine to: receive a message over a network, the message sent by a

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recipient system requesting an updated firmware image (e.g., col., 3); determine by a donor system whether a compatible image to the requested updated firmware image is available (e.g., col., 3); when the donor system has a compatible image, negotiate with the recipient system, the recipient system to use a predetermined policy to select the donor system from at least one donor system having a compatible image (e.g., col., 4); and when the donor system is selected from the at least one donor system having a compatible image, upload the compatible image to the recipient system (e.g., col., 4).

11. Referring to claim 15, Tobias discloses the claimed limitations as rejected above. Tobias also discloses wherein negotiating comprises instructions that cause the machine to: send an acknowledgement offer to the recipient system; and receive an acceptance acknowledgement for the offer (e.g., col., 4).

12. Referring to claim 16, Tobias discloses the claimed limitations as rejected above. Tobias also discloses a system for automatic firmware image update, comprising: a recipient server having at least one processor; a baseboard management controller (BMC) operatively coupled to the at least one processor (e.g., col., 3), wherein the BMC comprises a BMC processor (e.g., col., 3), a memory operatively coupled to the BMC processor (e.g., col., 3), a communication interface enabling at least one of wireless network (e.g., col., 3), chassis management bus and local area network communication; and executable code loaded in memory accessible to the BMC processor (e.g., col., 3) that when executed enables the BMC to: determine whether operational firmware requires update (e.g., col., 4); send a request for an updated image via a network

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communication interface to a donor server in the network (e.g., col., 4); negotiate with the donor server for a compatible image using a predetermined policy to select the donor server from a set of at least one donor server having a compatible image (e.g., col., 4); and load an updated compatible image in non-volatile memory on the BMC (e.g., col., 4).

13. Referring to claim 20, Tobias discloses the claimed limitations as rejected above. Tobias also discloses a method for providing a firmware image, comprising: receiving a message over a network, the message sent by a recipient system requesting an updated firmware image(e.g., col., 3); determining by a donor system whether a compatible image is available; when the donor system has a compatible image, negotiating with the recipient system using a predetermined policy to select the donor system from at least one donor system having a compatible image (e.g., col., 4); and when the donor system is selected from the at least one donor system having a compatible image, uploading the compatible image to the recipient system (e.g., col., 4).

14. Referring to claim 21, Tobias discloses the claimed limitations as rejected above. Tobias also discloses wherein negotiating comprises: sending an acknowledgement offer to the recipient system; and receiving an acceptance acknowledgement for the offer (e.g., col., 4).

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15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-7, 10-13, 17-19, 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tobias in view of "Official Notice". Tobias discloses the claimed limitations as rejected above and wherein retrieving a compatible updated BIOS image comprises identifying a predetermined location having a compatible image (e.g., col., 3); and retrieving the compatible image from the predetermined location, wherein the predetermined location is selected from the group of locations consisting of a locally stored memory location, a locally stored non-volatile storage, a location accessible over a network, a storage location accessible by a predetermined processor, a web server, and an out of band input/output device accessible by the BMC while the recipient system is held in one of a reset state and inoperable state (e.g., col., 3), wherein the locally stored non-volatile storage is one of a Universal Serial Bus (USB) device, and a Personal Computer Memory Card International Association (PCMCIA) flash card, wherein retrieving a compatible updated BIOS image comprises: negotiating with a donor system based on a received acknowledgement that the donor system has a compatible image (e.g., col., 3), using a predetermined policy to select the donor system from a set of at least one donor system having a compatible image; and then uploading the compatible image sent by the donor system to the recipient system and usage of local area network (e.g., col., 4).

. However, Tobias does not specifically mention about the further claimed limitations of the claims, i.e., usage of out-of-band connection, management console,

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peer server, and wherein updating is performed while in a power state selected from the group of power states consisting of direct current (DC) power on and DC power off.

“Official Notice” is taken that both the concept and advantages of providing the claimed out-of-band connection, management console, peer server, and wherein updating is performed while in a power state selected from the group of power states consisting of direct current (DC) power on and DC power off is well known and expected in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include out-band connection, management console, peer server, and wherein updating is performed while in a power state selected from the group of power states consisting of direct current (DC) power on and DC power off with the teachings of Tobias in order to facilitate the well known usage of out-of-band connection, management console, peer server, and wherein updating is performed while in a power state selected from the group of power states consisting of direct current (DC) power on and DC power off because the out-of-band connection can gain access to information presently available only to an In-Band stack. The local area network, management console, peer server coupled to the network would support communicating messages for the recovery. The updating for the recovery performed at DC power on or off would ensure that the recovery is achieved without manual intervention and regardless of the DC power status.

16. Claims 1, 3-5, 8-11, 14-17, 20-23, are rejected under 35 U.S.C. 102(e) as being anticipated by Kutch 20050038808 (Hereinafter Kutch).

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17. Referring to claim 1, Kutch discloses a method for automatic firmware image recovery, comprising: determining that a firmware image for server management operational code in a recipient system needs to be replaced (e.g., col., 2); sending a message over a network by the recipient system, wherein the message requests a compatible replacement firmware image (e.g., col., 2); negotiating with a donor system based on a received acknowledgement that the donor system has a compatible image (e.g., col., 3), using a predetermined policy to select the donor system from a set of at least one donor system having a compatible image (e.g., col., 3), wherein at least one donor server of the set of at least one donor system sends an acknowledgement to the recipient system in response to the sent message (e.g., col., 3); uploading a compatible image sent by the donor system to the recipient system; and updating the recipient system firmware with the uploaded compatible image (e.g., col., 3).

18. Referring to claims 4, 10, 17, 23, Kutch discloses the claimed limitations as rejected above. Kutch also discloses wherein the message is sent via an out-of-band (OOB) connection (e.g., page 2).

19. Referring to claims 5, 11, Kutch discloses the claimed limitations as rejected above. Kutch also discloses wherein the baseboard management controller residing on the recipient system is capable of communicating to donor systems via at least one communication means, wherein the communication means is selected from a group consisting of a local area network (LAN), a wireless access point, a wired inter-chassis management bus (ICMB), and a Bluetooth® protocol wireless network (e.g., page 2).

20. Referring to claim 8, Kutch discloses the claimed limitations as rejected above. Kutch also discloses a machine accessible storage medium containing instructions that, when executed, cause a machine to: determine that a firmware image for server BIOS code in a recipient system needs to be replaced (e.g., col., 3); send a message over a network by a baseboard management controller on the recipient system, wherein the message requests a compatible replacement firmware image (e.g., col., 3); negotiate with a donor system based on a received acknowledgement that the donor system has a compatible image (e.g., col., 4), using a predetermined policy to select the donor system from a set of at least one donor system having a compatible image (e.g., col., 4), wherein at least one donor system of the set of at least one donor system sends an acknowledgement to the recipient system in response to the sent message (e.g., col., 4); upload a compatible image sent by the donor system to the recipient system (e.g., col., 4); and update the recipient system firmware with the uploaded compatible image (e.g., col., 4).

21. Referring to claim 14, Kutch discloses the claimed limitations as rejected above. Kutch also discloses a machine accessible medium containing instructions that, when executed, cause a machine to: receive a message over a network, the message sent by a recipient system requesting an updated firmware image (e.g., col., 3); determine by a donor system whether a compatible image to the requested updated firmware image is available (e.g., col., 3); when the donor system has a compatible image, negotiate with the recipient system, the recipient system to use a predetermined policy to select the

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donor system from at least one donor system having a compatible image (e.g., col., 4); and when the donor system is selected from the at least one donor system having a compatible image, upload the compatible image to the recipient system (e.g., col., 4).

22. Referring to claim 15, Kutch discloses the claimed limitations as rejected above. Kutch also discloses wherein negotiating comprises instructions that cause the machine to: send an acknowledgement offer to the recipient system; and receive an acceptance acknowledgement for the offer (e.g., page 3).

23. Referring to claim 16, Kutch discloses the claimed limitations as rejected above. Kutch also discloses a system for automatic firmware image update, comprising: a recipient server having at least one processor; a baseboard management controller (BMC) operatively coupled to the at least one processor (e.g., col., 3), wherein the BMC comprises a BMC processor (e.g., col., 3), a memory operatively coupled to the BMC processor (e.g., col., 3), a communication interface enabling at least one of wireless network (e.g., col., 3), chassis management bus and local area network communication; and executable code loaded in memory accessible to the BMC processor (e.g., col., 3) that when executed enables the BMC to: determine whether operational firmware requires update (e.g., col., 4); send a request for an updated image via a network communication interface to a donor server in the network (e.g., col., 4); negotiate with the donor server for a compatible image using a predetermined policy to select the donor server from a set of at least one donor server having a compatible image (e.g., col., 4); and load an updated compatible image in non-volatile memory on the BMC (e.g., col., 4).

24. Referring to claim 20, Kutch discloses the claimed limitations as rejected above. Kutch also discloses a method for providing a firmware image, comprising: receiving a message over a network, the message sent by a recipient system requesting an updated firmware image(e.g., col., 3); determining by a donor system whether a compatible image is available; when the donor system has a compatible image, negotiating with the recipient system using a predetermined policy to select the donor system from at least one donor system having a compatible image (e.g., col., 4); and when the donor system is selected from the at least one donor system having a compatible image, uploading the compatible image to the recipient system (e.g., col., 4).

25. Referring to claim 21, Kutch discloses the claimed limitations as rejected above. Kutch also discloses wherein negotiating comprises: sending an acknowledgement offer to the recipient system; and receiving an acceptance acknowledgement for the offer (e.g., page 3).

26. Claims 4-7, 12-13, 18-19, 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kutch in view of “Official Notice”. However, Kutch does not specifically mention about the further claimed limitations of the claims, i.e., usage of management console, peer server, and wherein updating is performed while in a power state selected from the group of power states consisting of direct current (DC) power on and DC power off.

“Official Notice” is taken that both the concept and advantages of providing the claimed management console, peer server, and wherein updating is performed while in a power state selected from the group of power states consisting of direct current (DC) power on and DC power off is well known and expected in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include management console, peer server, and wherein updating is performed while in a power state selected from the group of power states consisting of direct current (DC) power on and DC power off with the teachings of Kutch in order to facilitate the well known usage of management console, peer server, and wherein updating is performed while in a power state selected from the group of power states consisting of direct current (DC) power on and DC power off because the management console, peer server coupled to the network would support communicating messages for the recovery. The updating for the recovery performed at DC power on or off would ensure that the recovery is achieved without manual intervention and regardless of the DC power status.

Allowable Subject Matter

27. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Further, the applicant is motivated to provide claims with the claimed subject matter of claims 8 / 16 along with the claimed limitations of claim 2.

Conclusion

In order to expedite the prosecution of this case, multiple references are used for the rejections to demonstrate that several references disclose the claimed subject matter of the claims.

Examiner has cited particular columns and line numbers and/or paragraphs and/or sections and/or page numbers in the reference(s) as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety, as potentially teaching, all or part of the claimed invention, as well as the context of the passage, as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is (571) 272-3973. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn, can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Haresh N. Patel/

Primary Examiner, Art Unit 2154

5/7/2008